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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,503	01/25/2002	David C. Issler	10294-607001	4327
7590	07/28/2004			EXAMINER
ST. ONGE STEWARD JOHNSON & REENS LLC 986 BEDFORD STREET STAMFORD, CT 06905-5619			STASHICK, ANTHONY D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/057,503	ISSLER, DAVID C.
Examiner	Art Unit	
Anthony D Stashick	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 26 April 2004.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-14,16-22,24,25 and 27-29 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-14,16-22,24,25 and 27-29 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 05 September 2003 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

**DETAILED ACTION**

*Drawings*

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on September 5, 2003 have been accepted. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance. Currently, no drawings have been submitted.

*Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 7, 18-20 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haag 1,724,349 in view of Masseron 6,691,432. Haag '349 discloses substantially all the limitations of the claims including the following: an outsole 1 and 3 having an inner surface (top surface of 1) including an opening (that located above opening 6 in heel lifts); a footbed 7 positioned over the inner surface of the outsole; the footbed 7 having a lower surface including a plug 9 configured to be inserted into the opening (see Figures 1 and 4); the opening has a perimeter commensurate with the perimeter of the plug for providing a watertight seal (the plug is shown to compress up against the opening walls, thereby forming the watertight seal. In fact, if the plug was not tight with the opening, the plug would simply fall free from the opening.); the footbed formed of a material having a first hardness characteristic (made of rubber) that is less than an outsole material (for instance TPU or even wood) having a second hardness characteristic; the plug 9 is formed of a material having a first hardness

characteristic that is less than an outsole material (for instance TPU or even wood) having a second characteristic; the footbed and the plug are formed of a material (both made of rubber) having substantially the same hardness; the opening is positioned in a heel area of the inner surface of the outsole (see Figures 1 and 4); an upper 2; an insole 7. Masseron '432 teaches that a sole can have a heel region that has an inner surface and an outer surface adapted to be in contact with a walking surface with an opening extending from the inner surface to the outer surface (see Figures 2, 3a, 9a-9c) and a plug 23 located within the opening and made of different materials to aid in preventing bottoming of the sole. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the opening of Haag '349 extend through the sole to the walking surface to aid in preventing bottoming out of the sole during impact. With respect to claims 18-20 and 23, the limitations of these method steps are met by the presence of the limitations in the product shown.

4. Claims 1, 7, 18 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schaff 1,717,122 in view of Masseron 6,691,432. Schaff '122 discloses substantially all the limitations of the claims including the following: an outsole B (including top layer of the heel as seen in Figure 1), having an inner surface (that facing the inner portion of the shoe upper) including an opening (that located near D) and having a heel area (see heel in Figure 1) and a toe area (see Figure 1); a footbed H positioned over the inner surface of the outsole and extending from the heel to the toe (see Figure 4, heel is shown with plug, then the arch area is clearly shown by I, and then that portion forward of I is the toe end); the footbed having a lower surface including a plug E configured to be inserted into the opening (see Figure 1); the opening has a perimeter commensurate with the perimeter of the plug for providing a watertight seal (the plug is shown to compress up against the opening walls, thereby forming the watertight seal. In fact, if the plug was not tight with the opening, the plug would simply fall free from the opening.); the opening is positioned in a heel region of the inner surface (see Figure 1); an upper (see Figure 1); an insole H. Masseron '432 teaches that a sole can have a heel region that

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has an inner surface and an outer surface adapted to be in contact with a walking surface with an opening extending from the inner surface to the outer surface (see Figures 2, 3a, 9a-9c) and a plug 23 located within the opening and made of different materials to aid in preventing bottoming of the sole. Therefore, it would have been obvious to make the opening of Haag '349 extend through the sole to the walking surface to aid in preventing bottoming out of the sole during impact. With respect to claims 18 and 23, the limitations of these method steps are met by the presence of the limitations in the product shown.

5. Claims 5, 6, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haag 1,724,349 and Masseron '432 as applied to claims 1 and 18 in view of Design Choice. Haag '349 in view of Masseron '432 discloses all the limitations substantially as claimed except for the specific hardnesses of the material used for the outsole, footbed and plug. It appears that it would have been a mere matter of design choice to choose the hardness of the material to be used for the footbed, plug and outsole to meet the desired function of cushioning the user's foot upon impact and durability of the sole. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the footbed, plug and outsole out of a material made of any desired hardness to aid in cushioning the user's foot and prevent wear, as desired.

6. Claims 2-6 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schaff 1,717,122 in view of Masseron '432 as applied to claims 1 and 18. Schaff '122 in view of Masseron '432 discloses all the limitations substantially as claimed. Schaff '122 in view of Masseron '432 does not specifically teach the material used for the footbed, plug and outsole. However, Schaff '122 does teach that the footbed and plug are cushions and that the sole is made to survive normal wear and tear. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the cushion and plug out of a material that is less hard than the sole, to provide cushioning, while making the outsole out of harder material to survive normal wear and tear of the sole

contacting the ground. With respect to the Shore hardness limitation, it appears that it would have been a mere matter of design choice to determine the hardness of the material to perform the desired function.

7. Claims 8-14, 16-17 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of the references as applied to claims 1 and 8 above in view of Lober 844,882. The references as applied to claims 1 and 8 above disclose all the limitations of the claims except for the plug having a cap section and a pedestal with a lip being formed by the cap. Lober '882 teaches that a plug depending from the bottom surface of a footbed and fitted within the opening of a sole can have a pedestal b and cap b' with the cap forming a lip extending past the perimeter of the pedestal. The lip of the cap preventing accidental removal of the plug from the opening of the sole. Therefore, it would have been obvious to make the plug of the references as applied to claims 1 and 8 above, with a pedestal and cap, as taught by Lober '882, to aid in holding the plug in the opening and prevent accidental removal of the plug from the opening. With respect to the perimeters of the cap and pedestal, Lober '882 meets these limitations in as much as that which is shown and disclosed by the applicant.

8. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schaff 1,717,122 in view of Masseron '432 as applied to claim 28 above in view of Lober 844,882. Schaff '122 in view of Masseron '432 discloses all the limitations of the claim except for the plug having first and second protrusions with different peripheries with the second protrusion being attached to the first protrusion and having a periphery larger than the periphery of the first protrusion. Lober '882 teaches that a plug can depend from the bottom surface of a footbed and be fitted within the opening of a sole; the plug can have a pedestal (first protrusion b) and cap (second protrusion b') with the cap forming a lip extending past the perimeter of the pedestal. The lip of the cap prevents accidental removal of the plug from the opening of the sole. Therefore, it would have been obvious to make the plug of Schaff '122 in view of

Masseron '432 as applied to claim 28 above, with a pedestal and cap, as taught by Lober '882, to aid in holding the plug in the opening and prevent accidental removal of the plug from the opening.

***Response to Arguments***

9. Applicant's arguments filed April 26, 2004 have been fully considered but they are not persuasive. Applicant argues that there is no suggestion to combine Masseron with Haag or Schaff. This argument is not clearly understood. In the last sentence of each rejection, the examiner gives the reason to combine, and therefore the rejections stand. Applicants argue that because the plug of Masseron moves relative to the well that it cannot have a watertight seal. This argument is not clearly understood. The moving of the plug along the wall does not make it not watertight, as the material of the plug fits tightly up against the walls of the chamber. Since Masseron is a friction fit and the plug and walls are made out of elastic material and, as shown in Figures 9a-c, the side walls of the plug cling to the walls of the opening to deform the plug when pressure is added (see curvature of plug end), this shows a tight seal that is watertight, i.e. no water can pass. Applicant further argues that a watertight seal would not be necessary in Haag or Schaff. This is also not clearly understood. A watertight seal would be desirable in Haag or Schaff to prevent perspiration buildup in the heel of the shoe. Therefore, with the teaching of Masseron, this seal would prevent the perspiration from the user's foot from dripping into the shell of the heel, prevention mold and mildew buildup.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday through Thursday from 6:30 am until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony D Stashick  
Primary Examiner  
Art Unit 3728

ADS